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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,663	09/30/2003	Richard I. Pudney	KP0001	5813

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PATENT DEPARTMENT
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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT PAPER NUMBER

3676

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,663

Applicant(s)

PUDNEY, RICHARD I.

Examiner

Gary Estremsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed 5/9/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 4, 6-8 and 10-13 is/are allowed.
- 6) ☒ Claim(s) 1, 5 and 9 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/30/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 1,923,411 to Armstrong.

Armstrong '411 teaches Applicant's claim limitations including : a "door handle" - 26, a "first bias spring" - 3, a "lock button" - 14, a "lever assembly" - including 21,22. The broadly-phrased functional recitations have been carefully considered but they do not define any particular structure of the claimed product that can be relied upon to patentably distinguish from the well known structure of the prior art otherwise reading on all explicitly-recited structure comprising scope of the claimed invention. See MPEP 2114.

More specifically as regards recitation of "the lock button is capable of inadvertently being moved to its locked position by at least operation of the door handle" - written description describes automatic function anticipating same at page 1, lines 2-9 and in detail at page 1; line 101- page 2; line 4 for example where "inadvertent" is nothing more than intention or lack of same but in neither case does its recitation patentably distinguish from structure inherently capable of being inadvertently used in

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the manner described. The reference explicitly discloses that operation of the handle for unlatching will automatically result in locking of the exterior handle, regardless of the whether user is aware of same or not. As indicated above, the latch of the prior art performs the functions and whether or not locking is the intention of the user, does not define the claimed invention (a product) from the structure of the prior art which is inherently capable of being operated in such a way that its locking is 'inadvertent'. More specifically as regards recitation of "a release of the door handle *under certain conditions* from its activated position initiates movement of the lock button to its locked condition", after turning handle 26 of the prior art, release of the handle and simultaneous pushing in of button 14 will initiate its movement to the locked position. This is not the only way to lock the exterior handle but such operation is an inherent capability of the prior art structure and anticipates the broad functionally-recited limitation since that limitation does not clearly define any particular structure that can be relied upon to patentably distinguish from the well known structure of the prior art. As regards a "lever assembly for blocking the lock button from moving to the locked position of the lock button in response to a return movement of the door handle from its actuated position to its rest position/", pressing 21 inwards during a quick release of the handle will inherently block 14 from moving inwards to its locked position.

As regards claim 9, contact of part 14 with the end of slot 12 of part 4 performs function of preventing the lever assembly from rotating further in the locking direction and is equivalent to stop structure presently disclosed.

3. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 2,200,714 to Falk.

Falk '714 teaches Applicant's claim limitations including : a "door handle" - 17, a "first bias spring" - one of ordinary skill in the art would recognize that teaching of the reference inherently includes a spring means for biasing the latch bolt outwardly where through its interaction with the spindle the handle is biased towards a latched rest position, a "lock button" - 41, a "lever assembly" - including 45. The broadly-phrased functional recitations have been carefully considered but they do not define any particular structure of the claimed product that can be relied upon to patentably distinguish from the well known structure of the prior art otherwise reading on all explicitly-recited structure comprising scope of the claimed invention. See MPEP 2114.

More specifically as regards recitation of "the lock button is capable of inadvertently being moved to its locked position by at least operation of the door handle" - prior art describes placement of 41 with respect to the handle 17 whereby both will be operated by a hand (Fig 1) where 'inadvertent' is nothing more than intention or lack of same but in neither case does its recitation patentably distinguish from structure inherently capable of being inadvertently used in the manner described.

More specifically as regards recitation of "a release of the door handle *under certain conditions* from its activated position initiates movement of the lock button to its locked condition", a hand allowing the handle to return to its released position and at the same time pressing 41 towards its locked position reads on broad recitation. See (col 2; lines 6-12). Examiner notes that while Applicant may have disclosed a specific

mechanical structure for performing the function, that structure is not specifically defined in the claim whereby it cannot patentably distinguish from a human hand that performs the recited function identically. As regards a "lever assembly for blocking the lock button from moving to the locked position of the lock button in response to a return movement of the door handle from its actuated position to its rest position", having part 45 in the unlocked position will prevent the lock button from moving towards the locked position no matter how quickly it is released.

Allowable Subject Matter

4. Claims 2,4,-6-8,10-13 allowed.
5. Claims 3 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments have been fully considered but they are not all entirely persuasive. Applicant's arguments rely upon an assumed requirement that an anticipatory reference must *explicitly* teach that a user of the prior art lock will cause locking function unintentionally. That is not entirely accurate. It is the examiner's position that the claim is for a *product* and must rely upon the *structure* defined therein. The claimed invention is not a *method* defined by its *steps*, and is not a frame of mind, defined by some intention. The recitation of "inadvertently" does not define clearly

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define particular structure of the claimed product and is for that reason, broad. The limitation has been treated as a capability and anticipatory prior art that is capable of performing the function, as broadly recited, whether that capability is either expressly or implicitly disclosed may be read on the recitation.

But furthermore, one of ordinary skill in the art should recognize that a lock (such as that of Armstrong '411) that is specifically designed to be automatically set into a locked position simply by operating its handle for unlatching is particularly subject to becoming unintentionally or otherwise inadvertently locked by a user unfamiliar with that feature of the lock. While the reference specifically discloses that locking may be performed without further specific action by the user, the limitation is broader and even a hypothetical lock provided with many complex safeguards to prevent inadvertent locking could become inadvertently locked by someone used to routinely performing the complex actions necessary for unlocking should that user for some reason act 'automatically' without conscious intention of locking.

As previously stated, the limitation does not define structure that can be relied upon to patentably distinguish from the prior art. In that respect, it has been held that a recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. See MPEP 2114. Furthermore, claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). The law of anticipation requires that a distinction be made between the invention described or taught and the invention

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claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789. contrary to Applicant's remarks, deletion of the term "at least" does not materially affect application of the reference to the claim since it is inherently capable of the function recited in the claim.

Should Prosecution be Continued, it is suggested that the claims be amended to include the elements/structure/arrangement disclosed for performing the broadly-recited functions. This suggestion should not be construed as an indication of allowable subject matter since it is not clear at this time what amendments Applicant might make. The suggestion is intended to expedite resolution of issues raised to date if Applicant decides to further pursue claim scope broader than that indicated to be allowable herein.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

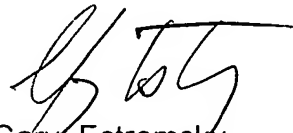
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is 571 272-7055. The examiner can normally be reached on M-Thur 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gary Estremsky
Primary Examiner
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